

applicant elected to prosecute after the Examiner imposed a restriction requirement. Applicants will address this application because of its priority status. Applicants' attorneys discussed the priority great grandparent and parent applications at the interview as well, and therefore will also address whether prosecution of the composition claims in the parent application bars the process claims of the present reissue application and whether the prosecution of article of manufacture claims in the great grandparent application bars the process claims of this reissue application.

The Examiner rejected the priority great grandparent and grandparent applications but applicants never responded to the rejections. Accordingly, the Examiner never issued a final rejection in either, and applicants neither amended them, canceled any claims from them, or submitted any arguments in them as to patentability, and never acquiesced to the rejections in any way, but rather filed a continuation-in-part PCT application based on both. That priority PCT application in turn became the basis for the parent application, and should not be confused with the non-priority PCT applications.

As to the non-priority PCT applications, applicants initially point out that 37 C.F.R. § 1.11 makes the present reissue application, available for public inspection, which includes this response. Because 37 C.F.R. §1.14 (Rule 14) provides for maintaining these non-priority PCT applications in confidence, applicants decline to specifically discuss them, or identify them by serial number and filing date, since Rule 14 also makes them available to the public if identified in a publicly available document. Applicants, however, will discuss the non-priority PCT applications generally to address the issues raised.

As to recapture, case law shows that the doctrine applies only to amendments or arguments that address patentability issues advanced during the course of prosecution of an application in order to overcome a rejection. Where an Applicant has not urged patentability in either way, recapture does not exist. *Ball Corp. v. United States*, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984); *In re Wallingham*, 282 F.2d, 353, 127 U.S.P.Q. 211-215 (C.C.P.A. 1960); *In re Wadlinger et al.*, 496 F.2d 1200, 181 U.S.P.Q. 826, 830, 832 (C.C.P.A. 1974). Also, "where claims have not been previously cancelled, relative claim scope is not available to illuminate the alleged error" *Ball*, 729 F.2d at 1434, 221 U.S.P.Q. at 295, and fn. 19 (Emphasis added).

As to applicants' filing the continuation-in-part rather than addressing the non-final rejections in the great grandparent and grandparent applications, the Court of Appeals for the Federal Circuit pointed out:

[t]he filing of a continuation-in-part, in and of itself is not an admission of the correctness of a rejection. Law and policy liberally authorize the filing of c-i-p applications for a number of reasons, whether to enlarge the disclosure to include new technological information, thereby providing the public with knowledge of recent developments or improvements; or to enable more extensive prosecution or improved draftsmanship of specification or claims; or to provide a vehicle for prosecution of non-elected claims.

Paperless Accounting v. Bay Area Rapid Transit System, 804 F.2d 659, 231 U.S.P.Q. 649, 652 (Fed. Cir. 1986). Also, where an Examiner has not made a final rejection, applicants' subsequent filing of a CIP application does not amount to acquiescence to any outstanding rejections in the parent application. *Paperless Accounting*, 804 F.2d at 231 U.S.P.Q. at 652.

An analysis of the various applications will show that the present application derives from the great grandparent, grandparent, PCT continuation-in-part, and parent applications. This chain of applications comprises the priority applications upon which applicants rely for their earliest filing date. Applicants have not incorporated the non-priority PCT applications in the chain that makes up the priority applications of the present case.

Members of the public and especially competitors of the applicants could not look to the non-priority PCT applications as bearing on the prosecution of the present reissue application, and therefore could not rely on any statements made by the applicants in those applications to determine the scope of protection applicants sought in the parent application. Applicants' did not give up any subject matter of any of the non-priority PCT applications in order to obtain allowance of claims in the parent application. Again, these non-priority PCT applications are not accessible to the public under Rule 14 and the Patent and Trademark Office should not require applicants to divulge their identity thereby making them accessible to the public under Rule 14. The Patent and Trademark Office preserves those applications in confidence, and Applicants respectfully request the Office to continue to preserve them in confidence.

The Examiner has allowed the reissue of process claims 1-27. As to the other reissue process claims 28-32, applicants point out that the great grandparent application does not include process claims¹

¹ Applicants' attorneys do not in any way intend to limit the claims of any of the great grandparent, grandparent, PCT, parent or reissue applications by the summaries of claims of those applications as set forth throughout this response.

Importantly, the Examiner never rejected composition claims 1-19 of the great grandparent application since applicants elected (with traverse) to prosecute article of manufacture claims 20-50 in that application in response to a restriction requirement. The Examiner therefore cannot look to the great grandparent application to apply the recapture doctrine to reissue claims 28-32.

Reissue process claims 28-32 do not recapture subject matter given up in the great grandparent application in order to advance prosecution or obtain an allowance. Although the Examiner made a prior art rejection of article claims 20-50, which applicants elected in response to a restriction requirement in the great grandparent application, applicants never cancelled the claims nor did they amend them, or present arguments of any kind in order to overcome the rejection. Subsequent to filing the great grandparent application (and for that matter, the grandparent application) applicants filed the PCT application and the parent application, which claims the priority of all three.

The Examiner never finally rejected article of manufacture claims 20-50 in the great grandparent application and accordingly, applicants never acquiesced to that rejection by filing a continuation-in-part application since "the filing of a continuation-in-part, in and of itself is not an admission of the correctness of a rejection," especially where the rejection is not a final rejection. *Paperless Accounting*, 231 U.S.P.Q. at 652. The prosecution history of the great grandparent application therefore does not raise any recapture issues regarding reissue claims 28-32.

Applicants incorporate their remarks of January 26, 2001 to distinguish the grandparent application, and again emphasize they did not respond in writing to a

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

restriction requirement, or prior art rejection made in the grandparent application, or through the parent application since not only did the grandparent restriction and rejection fail to carry over to the parent application for reasons that applicants pointed out in their January 26 response, but also the grandparent application related to method and article of manufacture claims and the parent application contained composition of matter claims.

Applicants have not recaptured claims of the same or broader scope than claims canceled from the grandparent application, and the Examiner cannot look to the Office Actions in the grandparent application as binding on the applicants in any way in the present application as bearing on recapture. Even though rejected on prior art grounds, Applicants' did not cancel any claims in response to a rejection in the grandparent application and did not offer any amendments or arguments to overcome rejections in the grandparent application. As stated in Ball Corp. v. United States, 729 F.2d 1434, 221 U.S.P.Q. 290, 295 f.n. 19, "where claims have not been previously canceled . . . relative claim scope is not available. . . ." to invoke the recapture rule. The court must look to other factors to determine how the error arose that gave rise to the reissue.

Accordingly, any subsequent prosecution in the parent application started out with a clean slate. Even though the claims in the grandparent application became abandoned, and applicants filed a continuation-in-part, PCT application, this does not amount to a cancellation of claims in the face of an outstanding rejection.

Additionally, the Examiner in the parent application did not consider the filing of that application as a response to any of the rejections in the great-grandparent and grandparent applications, but treated the parent application as a new United States

Application and did not refuse to acknowledge priority of the great-grandparent or grandparent applications in the United States prosecution.

In any event, the Examiner not making the rejection final, and the applicants' subsequent filing of the CIP application clearly shows that the applicants did not acquiesce to the rejection. Paperless Accounting v. Bay Area Rapid Transit System, 804 F.2d 659, 231 U.S.P.Q. 649 (Fed. Cir. 1987). In Paperless Accounting the Federal Circuit held that the non final rejections in a parent application did not carry over to a continuation-in-part (CIP), and the subsequent filing of the CIP was not an admission of the correctness of the rejection in the parent or acquiescence to the rejection

Conclusions

Applicants have not recaptured claims of the same or broader scope than claims canceled from the parent or original application. Applicants never presented process or method claims in the parent application, but only the grandparent application. Since applicants filed the parent application as a CIP based on the grandparent application, none of the rejections or restrictions in the grandparent application carried over to the CIP or parent application.

Even though rejected on prior art grounds and restricted, the applicants did not amend the grandparent application, present arguments as to patentability or cancel claims in order to overcome the prior art. The parent application never contained any process claims, and accordingly applicants could not have presented arguments, amended claims or canceled process claims to urge patentability of the process. As stated by the court in Ball, "where claims have not been previously canceled . . .

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

relative claim scope is not available. . . . " to invoke the recapture rule. The court must look to other factors to determine how the error arose that gave rise to the reissue. Accordingly, the present application does not recapture claims of the same or broader scope than those canceled from the original application.

If filing this response requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension fee or other fee which this response fails to account for, Applicants' attorneys request such an extension and payment of any fees due from their Deposit Account No. 06?0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Robert J. Eichelburg
Reg. No. 23,057

Dated: May 9, 2001

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000